REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-11, 13-19, and 21-38 are currently pending. Claims 1, 3, 22, and 24 have were amended by the Amendment filed March 3, 2009.

In the outstanding Office Action, Claims 1-11, 13-19, and 21 were rejected under 35 U.S.C. §101 as being directed to nonstatutory subject matter because "the claims do not provide a sufficient tie to another statutory class..."'; Claims 1, 6-9, 11, 13-17, 19, 21, 22, 27-30, 32-36, and 38 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,931,780 to Giger et al. (hereinafter "the '780 patent") in view of U.S. Patent No. 6,661,873 to Jabri et al. (hereinafter "the '873 patent"), further in view of U.S. Patent Application Publication No. 2004/0252873 to Avinash et al. (hereinafter "the '873 application"); and Claims 2-5, 10, 18, 21, 23-26, 31, and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the '780 patent, the '873 patent, and the '873 application, further in view of U.S. Patent No. 6,282,307 to Armato, III et al. (hereinafter "the '307 patent").

Applicants respectfully submit that the '873 application is no longer available as a prior art reference under 35 USC § 102(e) in view of the attached Declaration under 37 C.F.R. § 1.131, which establishes that Applicants conceived of and reduced to practice the invention recited in at least independent Claims 1, 14, 22, and 33 prior to the filing date of the '873 application (June 13, 2003). Accordingly, Applicants respectfully submit that the outstanding rejections of Claims 1-11, 13-19, and 21-38 under 35 U.S.C. § 103(a), all of which are based in part on the '873 application, are rendered moot.

The Federal Circuit has stated that "[c]onception is the 'formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is

hereafter to be applied in practice' "[1] and that "[c]onception is the touchstone of inventorship, the completion of the mental part of invention."[2] As stated in the attached declaration, Heber MacMahan and his co-inventor, conceived of the invention recited in at least independent Claims 1, 14, 2, and 33 by at least March 2003. In this regard, attached herewith is an Invention Disclosure, which was submitted to the University of Chicago Office of Technology and Intellectual Property in August, 2003. Section 5A of the Invention Disclosure states that the invention recited in at least independent Claims 1, 14, 2, and 33 was conceived of by at least March 2003.

Further, as stated in the declaration, Heber MacMahon and his co-inventor first reduced to practice and demonstrated the invention recited in at least independent Claims 1, 14, 2, and 33 by March 2003, as evidenced by Section 5D of the above-mentioned Invention Disclosure and the software program listing submitted herewith.

In addition, as stated in the declaration, on June 8, 2003, Heber MacMahon gave a presentation entitled "Computer-Assisted Diagnosis: Breast and Thoracic Imaging," submitted herewith, at the 20th Symposium for Computer Applications in Radiology, Annual Meeting 2003 (Boston, MA), as shown by page 7 of the attached program of that conference. The presentation illustrates the method and apparatus as currently appearing in at least Claims 1, 14, 22, and 33.

Thus, for the reasons stated above, Applicants respectfully submit that the '873 application is no longer available as a prior art reference under 35 USC § 102(e) in view of the attached Declaration under 37 C.F.R. § 1.131, since Applicants conceived of and first reduced to practice the invention recited in at least independent Claims 1, 14, 22, and 33, prior to the filing date of the '873 application.

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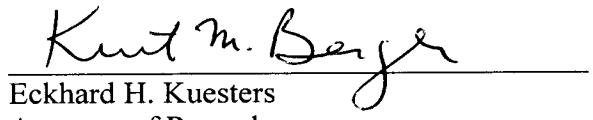
[1] Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986) (quoting 1 Robinson on Patents 532 (1890)). See also Sewall v. Walters, 21 F.3d 411, 415, 30 USPQ2d 1356, 1359 (Fed. Cir. 1994) ("Conception is complete when one of ordinary skill in the art could construct the apparatus without unduly extensive research or experimentation").
[2] Sewall, 21 F.3d 411, 415, 30 USPQ2d 1356, 1359 (Fed. Cir. 1994).

Accordingly, as stated above, Applicants respectfully submit that the outstanding rejections of Claims 1-11, 13-19, and 21-38 under 35 U.S.C. § 103(a), all of which are based in part on the '873 application, are rendered moot.

Consequently, in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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